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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,559	09/26/2003	Tsuyoshi Kaneko	116945	8128
25944	7590	09/12/2006	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			NASRI, JAVAID H	
			ART UNIT	PAPER NUMBER
			2839	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/670,559	KANEKO, TSUYOSHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Javaid Nasri	2839	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16, 18-25 and 28-31 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15 and 26 is/are rejected.
- 7) ☒ Claim(s) 11 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Lorenzo et al (5,163,118, cited in previous office action).

Lorenzo et al discloses, **for claim 26**, a first convex member (34) provided on a substrate (30); an optical waveguide member (38) provided solely on an upper surface of the first convex member (see figure 2G), a second convex member provided on the substrate, the second convex member being disposed in parallel with the first convex member; and a covering layer (42) that covers an optical waveguide member and is provided in a part on an upper surface of the second convex member (depends on the orientation).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzo et al. in view of Malone et al (5,402,511, cited in previous office action regarding refractive index limitation)

- a) For claims 1-10 and 12-15, Lorenzo et al. discloses all the structural limitations of claims 1-10 and 12-15, as shown above, and Malone et al discloses the refractive index limitation, see previous office action.

However, Lorenzo et al. does not disclose:

- 1) the claimed language, the claimed method language is counter member of the apparatus claimed.

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to develop a particular method for the disclosed apparatus of the cited references.

#### ***Allowable Subject Matter***

5. Claims 11 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 16, 18-25 and 28-31 allowed.

#### **REASONS FOR ALLOWANCE**

7. The following is an examiner's statement of reasons for allowance:

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The reason for allowance of the claims is the inclusion of the limitation,

- a) For claims 16 and 31, none of the prior art teaches or suggest, alone or in combination a maximum width of maximum cross-section of the optical waveguide member being longer than a width of a lower surface of the optical waveguide member, in combination with other limitations in the claim which is not found in the prior art reference of record.
- b) For claims 11 and 27, none of the prior art teaches or suggest, alone or in combination the optical waveguide includes two of the second convex members and the first convex member being disposed between the two-second convex members, in combination with other limitations in the claim, which is not found in the prior art reference of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Response to Arguments***

8. Applicant's arguments filed 6/29/2006 have been fully considered but they are not persuasive.

Regarding applicant's comments:

- a) Lorenzo et al does not disclose that the second convex member is provided on the substrate. It should be noted that the second convex member is provided on the substrate indirectly, see figure 3E and note below.
- b) Lorenzo et al in view Malone et al does not disclose the method steps. It should be noted that the rejection is obvious as noted in the rejection above.

Note: USPTO interprets claims, giving claims their "broadest reasonable interpretation."  
(See, e.g., In re Morris, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997)).

### *Conclusion*

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

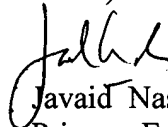
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**Contact**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javaid Nasri whose telephone number is 571 272 2095. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tulsidas C. Patel can be reached on 571 272 2800 ext 39. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Javaid Nasri  
Primary Examiner  
Art Unit 2839

JN

Jhn

September 6, 2006